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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,849	08/25/2006	Ikuya Kikuchi	46969-5449	3807
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EXAMINER				
GUPTA, PARUL H				
ART UNIT		PAPER NUMBER		
2627				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/590,849

**Applicant(s)**

KIKUCHI, IKUYA

**Examiner**

PARUL GUPTA

**Art Unit**

2627

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/10/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The submitted IDS documents have been reviewed and made of record.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 1-3,5,7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the acknowledged prior art, or the JP document 2001-307370, either further considered with Lee et al and further considered with Suzuki et al.

With respect to the limitation of claims 1, 7, and 9, either the acknowledged prior art or Jp 2001-307370, i.e. the acknowledged prior art identified as JP 10-106012 in the

specification is relied upon for disclosing the basic optical system lacking the particular "light shielding panel" and position thereof. Similarly, the JP 2001-307370 document is relied upon for the reasons stated in the submitted search report - see noted paragraphs 30-36, 45-46, and claims 1 & 2 as identified in the submitted EP document search report. The examiner concludes that such portions also lack the above noted "light shielding panel" and positioning location.

The ability of "shielding" the amount of light projected/focused onto a multi-layered or multiple diverse record media is well established as taught by the Lee et al reference - see for instance the discussion of element 110 in this document.

In additional, the placement of an appropriate "light shielding" element and the objective lens and the light detector at the conjugate plane/position with respect to an emission point of the light beam is also well known in the optical arts – see for instance in Suzuki et al the discussion with respect to element 11 in figure 1.

It would have been obvious to modify either of the base systems with the above noted teachings from the secondary references; motivation is to ensure proper signal C/N, intensity, reduction of interference upon reflected light, etc. as is taught by the above secondary systems. One of ordinary skill in the art would place the appropriate light controlling element at an optimum position (such as the imaging plane/conjugate position) for such a purpose.

With respect to the limitation of claim 2, i.e., a driver, such is considered inherent in the overall combination of elements, i.e., use of such standard mechanical

components, i.e. a driver for their inherent capability/use in this environment is necessary in order to correct for system distortions such as aberration.

With respect to claims 3, 5 and 8, that is the purpose of the overall light shielding element, i.e., shield the reflected light. The diameter of the pin hole/aperture/diaphragm is predicated upon the spot size required/necessary to rec/reproduce the information on the record media, and hence is an obvious requirement.

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Ueyama.

The Ueyama reference is the equivalent US/English system of the cited JP 9-161282 document relied upon in the EP search report for teaching such an element.

The examiner relies upon those corresponding passages equivalent to the paragraphs cited in the JP document as also teaching this limitation.

It would have been obvious to modify the base systems as relied upon above with this additional teaching, motivation is as discussed in the Ueyama reference.

### ***Response to Arguments***

Applicant's arguments filed 11/10/08 have been fully considered but they are not persuasive. Applicant argues that the given elements are not taught to be in a conjugate relationship. The examiner disagrees. As claimed, the term "conjugate relationship" is broad and is defined as "joined together" without more specifics. Thus, as figure 1 of Suzuki et al. shows all of the given elements in the same device, the elements can be described as being joined together and thus, in a conjugate relationship.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PARUL GUPTA whose telephone number is (571)272-5260. The examiner can normally be reached on Monday through Thursday, from 10 AM to 7 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph H. Feild/  
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